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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,653	03/15/2004	Tomoko Kimura		8582

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MATTINGLY, STANGER & MALUR, P.C.
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EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,653

Applicant(s)

KIMURA ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 42-46 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent 6,289,452) in view of Benson et al. (U.S. Patent 5,845,281). Arnold discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of first digital contents; storing in a digital contents personal using condition

management table in the digital contents sales apparatus, a first digital contents personal using condition including first identification information of said purchased first digital contents and first information of personal using conditions of said first digital contents to said user; in response to an input of identification information of said user, searching, from said digital contents personal using condition management table, at least said first digital contents personal using condition corresponding to said identification information of said user; and transmitting a BOB (Bag of Bits) to the user via the network (column 5, line 37, through column 6, line 39). Arnold does not disclose that the BOB is or comprises a personal using condition list page, but Benson teaches generating a set of personal using conditions which may be specific to a user and therefore involve user identification, and having it included in a data object of digital contents (Abstract; column 5, lines 16-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate such a personal using condition list page, and transmit it to the user, for the stated advantage of managing a data object so as to comply with predetermined conditions for the usage of the data object (and, e.g., avoid losing revenue to unauthorized use).

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent 6,289,452) in view of Benson et al. (U.S. Patent 5,845,281). Arnold discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method

comprising the steps of: receiving, from a user via the network, an input for indicating purchase of first digital contents; storing in a digital contents personal using condition management table in the digital contents sales apparatus, a first digital contents personal using condition including first identification information of said purchased first digital contents and first information of personal using conditions of said first digital contents to said user; in response to an input of identification information of said user, searching, from said digital contents personal using condition management table, at least said first digital contents personal using condition corresponding to said user; and transmitting a BOB (Bag of Bits) to the user via the network (column 5, line 37, through column 6, line 39). Arnold does not disclose that the BOB is or comprises a personal using condition list page, but Benson teaches generating a set of personal using conditions specific to a data object and therefore involving identification of the data object (first digital contents), and having it included in a data object of digital contents (Abstract; column 5, lines 16-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate such a personal using condition list page, and transmit it to the user, for the stated advantage of managing a data object so as to comply with predetermined conditions for the usage of the data object (and, e.g., avoid losing revenue to unauthorized use).

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent 6,289,452) in view of Benson et al. (U.S. Patent 5,845,281). Arnold discloses a digital contents sales method for selling digital contents in a digital contents

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sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of first digital contents; storing in a digital contents personal using condition management table in the digital contents sales apparatus, a first digital contents personal using condition including first identification information of said purchased first digital contents and first information of personal using conditions of said first digital contents to said user; reading said digital contents personal using conditions corresponding to said user from said digital contents personal using condition management table; and transmitting a BOB (Bag of Bits) to the user via the network (column 5, line 37, through column 6, line 39). Arnold does not disclose that the BOB is or comprises a personal using condition list page, but Benson teaches generating a set of personal using conditions which may be specific to a user and therefore involve user identification, and having it included in a data object of digital contents (Abstract; column 5, lines 16-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate such a personal using condition list page, and transmit it to the user, for the stated advantage of managing a data object so as to comply with predetermined conditions for the usage of the data object (and, e.g., avoid losing revenue to unauthorized use).

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent 6,289,452) in view of Benson et al. (U.S. Patent 5,845,281) and Haff (U.S. Patent 6,219,669). Arnold discloses a digital contents sales method for selling digital

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contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of first digital contents; storing in a digital contents personal using condition management table in the digital contents sales apparatus, a first digital contents personal using condition including first identification information of said purchased first digital contents and information of personal using conditions of said first digital contents to said user; in response to an input of identification information of said user, searching, from said digital contents personal using condition management table, at least said first digital contents personal using condition corresponding to said identification information of said user; and transmitting a BOB (Bag of Bits) (i.e. first digital contents) to the user via the network (column 5, line 37, through column 6, line 39). Arnold does not disclose that the BOB is or comprises a personal using condition list page, but Benson teaches generating a set of personal using conditions which may be specific to a user and therefore involve user identification, and having it included in a data object of digital contents (Abstract; column 5, lines 16-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate such a personal using condition list page, and transmit it to the user, for the stated advantage of managing a data object so as to comply with predetermined conditions for the usage of the data object (and, e.g., avoid losing revenue to unauthorized use).

Arnold does not expressly disclose receiving from the user via the network a request for retransmitting one of the digital contents displayed in the personal using

condition list page, and retransmitting said digital contents requested, if said digital contents personal using condition corresponding to said digital contents request is valid, but Arnold but does disclose attempting to retransmit the digital contents if the download be interrupted (column 6, lines 29-34); also, Haff teaches that if the transfer of a file is interrupted, the receiving machine informs the sending machine (column 7, lines 7-15; column 28, lines 14-26). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive such a request for retransmitting, and retransmit accordingly, if the using condition was valid, for the obvious and implied advantage of providing digital contents to recipients who are supposed to receive them, in the case of difficulties having arisen in transmission.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent 6,289,452) in view of Benson et al. (U.S. Patent 5,845,281) and Haff (U.S. Patent 6,219,669). Arnold discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of first digital contents; storing, in a digital contents personal using condition management table in the digital contents sales apparatus, a first digital contents personal using condition including first identification information of said purchased first digital contents and information of personal using conditions of said first digital contents to said user; and transmitting a BOB (Bag of Bits) (i.e. first digital contents) to the user via the network (column 5, line 37, through column

6, line 39). Arnold does not disclose that the BOB is or comprises a personal using condition list page, but Benson teaches generating a set of personal using conditions which may be specific to a user and therefore involve user identification, and having it included in a data object of digital contents (Abstract; column 5, lines 16-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate such a personal using condition list page, and transmit it to the user, for the stated advantage of managing a data object so as to comply with predetermined conditions for the usage of the data object (and, e.g., avoid losing revenue to unauthorized use).

Arnold does not expressly disclose that a physical act restriction is built into the personal using condition, but Benson teaches such a physical act restriction built into personal using conditions for digital contents (column 15, lines 1-14). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a physical act restriction to be built into the personal using condition, for the obvious and implied advantage of controlling physical acts affecting the value of the digital contents, as in preventing or limiting printing of digital contents, so as collect more money from those likely to have more money.

Arnold does not expressly disclose receiving from the user via the network a request for retransmitting one of the digital contents displayed in the personal using condition list page, and retransmitting said digital contents requested, if said digital contents personal using condition corresponding to said digital contents request is valid, but Arnold but does disclose attempting to retransmit the digital contents if the download

be interrupted (column 6, lines 29-34); also, Haff teaches that if the transfer of a file is interrupted, the receiving machine informs the sending machine (column 7, lines 7-15; column 28, lines 14-26). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive such a request for retransmitting, and retransmit accordingly, if the using condition was valid, for the obvious and implied advantage of providing digital contents to recipients who are supposed to receive them, in the case of difficulties having arisen in transmission.

Response to Arguments

Applicant's arguments with respect to claims 42-46 have been considered but are moot in view of the new ground(s) of rejection. In response to Applicant's amendments, Examiner has applied Arnold as the new primary reference.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wyman (U.S. Patent 5,260,999) discloses filters in a license management system. Rose (U.S. Patent 5,708,709) discloses a system and method for managing try-and-buy usage of application programs. Hasebe et al. (U.S. Patent 5,935,243) disclose a licensee notification system. Yamamura (U.S. Patent 6,023,766) discloses a software license control system and software license control equipment. Yagawa et al. (U.S. Patent 6,751,598) disclose a digital content distribution system and protection method.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

October 15, 2007